Remarks

Reconsideration and reexamination of the present application are respectfully requested. Claims 1-7 and 9-19 are pending in the present application. Of the pending claims, claims 1 and 11 are the only independent claims.

Priority

In the final Office Action mailed July 1, 2004, the Examiner noted the following:

1. The Applicant has indicated that the present application claims "the benefit under Title 35, United States Code, 120 of any United States application(s) listed below", listed as PCT/EP02/05877 [filed May 29, 2002]. The Examiner posited that since "this [PCT] application" is not a United States Application, the priority claim under 35 U.S.C. § 120 is not valid. The Examiner further posited that PCT/EP02/05877 was published on December 5, 2002, which was before the filing date of the present application.

2. The Examiner acknowledged the Applicant's claim for foreign priority under 35 U.S.C. § 119(a)-(d) based upon an application [DE 101 26 168.3] filed May 30, 2001. The Examiner posited that a claim for priority under 35 U.S.C. § 1.119(a)-(d) cannot be based on the DE application since the present application was filed more than 12 months thereafter.

For the reasons provided below, the Applicant respectfully traverses the Examiner's position regarding the priority of the present application and posits that the present application has a priority date of May 30, 2001 which is the filing date of the DE application.

The present application is a continuation of a PCT application [PCT/EP02/05877] which designated the United States. As such, the present application is

known as a "bypass" application filed under the provisions of 35 U.S.C. § 111(a), 363, and 365(c). (See MPEP § 1895-1896). The Applicant notes that the "bypass" route is an alternative to the more conventional national stage route provided by 35 U.S.C. § 371.

As set forth in MPEP § 1895, 35 U.S.C. § 363 provides that "an international application [i.e., PCT/EP02/05877] designating the United States shall have the effect, from its international filing date [i.e., May 29, 2002] under article 11 of the treaty, of a [U.S.] national application filed in the [U.S.] Patent and Trademark Office . . ." As set forth in MPEP § 1895, 35 U.S.C. § 365(c) provides that "in accordance with the conditions and requirements of section 120 of this title, . . . a [U.S.] national application shall be entitled to the benefit of the filing date of a prior international application designating the United States." Accordingly, the present application is entitled to the benefit of the filing date [May 29, 2002] of the prior PCT/EP02/05877 international application under 35 U.S.C. § 120.

As set forth in MPEP § 1895, a continuing application under 35 U.S.C. § 365(c) and 120 must be filed before the abandonment or patenting of the prior application. The date the PCT/EP02/05877 international application became abandoned was one day after 30 months from the filing date of the DE application which was filed May 30, 2001. As such, the 30 month date is November 30, 2003. The present application was filed October 3, 2003 and hence was filed before the abandonment of the prior PCT/EP02/05877 international application.

MPEP § 1895 indicates that to obtain the "benefit under 35 U.S.C. § 120 of a prior PCT application designating the U.S., the continuing U.S. national application must" (A) include an appropriate reference to the prior PCT application in the first sentence of the specification (this requirement has been as the first page of the Applicant's specification includes the appropriate reference); (B) be copending with the prior PCT application (this requirement has been met as the present application was filed prior to the abandonment of the PCT application); (C) have at least one inventor in common with the prior PCT application

(this requirement met as inventorship is identical between the present application and the prior PCT application).

MPEP § 1895.01(II) indicates that "a continuation application under 35 U.S.C. § 111(a) of the international application may be filed" and that "pursuant to 35 U.S.C. § 365(c), a regular national application filed under 35 U.S.C. § 111(a) . . . may claim benefit of the filing date of an international application which designates the United States." The PCT/EP02/05877 international application designates the United States. MPEP § 1895.01(II) further indicates that the "continuing application must be filed before the international application becomes abandoned . . . [this condition has been met as indicated above]. The specific reference to the international application required under 35 U.S.C. § 120 must appear either in the first sentence of the specification . . . An example of an appropriate first sentence of the specification is, for example, 'This is a continuation of International Application PCT/EP90/00000, with an international filing date of January 4, 1990, now abandoned [this condition has been met as the first sentence in the Applicant's specification conforms with the example].'"

MPEP § 1895.01(II) further indicates that "a claim for foreign priority under 35 U.S.C. § 119(a)-(d) must be made in the continuing application in the same manner as a claim for foreign priority under 35 U.S.C. § 365(b) in a national stage application, a foreign priority claim is proper if (1) a claim for foreign priority was made in the international application [this condition met as indicated on the front page of the PCT/EP02/05877 international application], and (2) the foreign application was filed within 12 months prior to the international filing date [this condition met as DE 101 26 168.3 was filed May 30, 2001 which was within 12 months of the filing date May 29, 2002 of PCT/EP02/05877]. A certified copy of any foreign priority document must be provided by the applicant if the parent international application has not entered the national stage under 35 U.S.C. § 371 [the Applicant filed a certified copy of DE 101 26 168.3 on April 13, 2004]."

The Applicant notes that MPEP § 1896 lists the differences between a national stage application filed under 35 U.S.C. § 111(a) [such as the present application] and a national stage application submitted under the more conventional route provided by 35 U.S.C. § 371.

Therefore, the priority claim under 35 U.S.C. § 120 of the present application to PCT/EP02/05877 is valid and the foreign priority claim of under 35 U.S.C. § 119(a)-(d) of the present application to DE 101 26 168.3 is valid. As such, the priority date of the present application is May 30, 2001 [i.e., the filing date of DE 101 26 168.3].

Claim Rejections - 35 U.S.C § 103

The Examiner rejected claims 1-6 and 11-16 (which include independent claims 1 and 11) under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2003/0122515 issued to Lutter et al. ("Lutter") in view of U.S. Patent No. 4,583,190 issued to Salb ("Salb"). The Examiner rejected claims 7, 9, 10 and 17-19 under 35 U.S.C. § 103(a) as being unpatentable over Lutter in view of Salb and further in view of U.S. Patent No. 6,459,223 issued to Mauel et al. ("Mauel").

The Applicant respectfully traverses the rejection to the claims under 35 U.S.C. § 103(a) and believes that the claimed invention is patentable over any combination of Lutter, Salb, and Mauel. However, regardless of the substantive differences between the claimed invention and the combination of Lutter, Salb, and Mauel the Applicant respectfully submits for the reasons below that Lutter is not a prior art reference under 35 U.S.C. § 103(a) to the present application.

A. Lutter does not qualify as a Reference under 35 U.S.C. § 103(a)

The priority date of the present application is May 30, 2001. Lutter was published July 3, 2003 and is based on a PCT application filed June 1, 2001. As such, the earliest possible date of Lutter as a prior art reference under 35 U.S.C. § 102(e) is June 1,

2001 which is after the priority date of the present application. However, the PCT application of which Lutter is based on was not published in English. (The PCT application of which Lutter is based on was filed in German.) As such, the date of Lutter as a prior art reference under 35 U.S.C. § 102(e) is the published date of July 3, 2003. (See MPEP 1896(II). Regardless, both possible dates of Lutter (July 3, 2003 and June 1, 2001) are after the priority date (May 30, 2001) of the present application. As such, Lutter does not qualify as prior art under 35 U.S.C. § 102(e) to the present application. Lutter does not qualify as prior art to the present application under any of the other provisions of 35 U.S.C. § 102.

Accordingly, as Lutter does not qualify as prior art under 35 U.S.C. § 102, Lutter is not prior art under 35 U.S.C. § 103(a). For at least this reason, the Applicant respectfully requests reconsideration and withdrawal of the rejection to claims under 35 U.S.C. § 103(a) in view of Lutter, Salb, and Mauel.

B. 35 U.S.C. § 103(c) Precludes Lutter as a Reference under 35 U.S.C. § 103(a)

Even if Lutter were prior art under 35 U.S.C. § 103(a), the Applicant respectfully submits that 35 U.S.C. § 103(c) disqualifies Lutter from being prior art against the present invention under 35 U.S.C. § 103(a).

35 U.S.C. § 103 (c) provides that:

> Subject matter developed by another person, which qualifies as prior art under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

The present application and Lutter were, at the time the invention of the present application was made, owned by Leopold Kostal GmbH & Co. KG ("the Assignee"). The Assignee is the owner of the entire right, title, and interest in and to the invention of the present application by virtue of assignment, filed on January 9, 2004 with the U.S. Patent

Office (recordation information not yet available). The Assignee is the owner of the entire right, title, and interest in and to Lutter by virtue of assignment, recorded on September 12, 2002 at Reel 013584, Frame 0637.

Therefore, 35 U.S.C. § 103(c) provides that Lutter does not qualify as prior art under 35 U.S.C. § 103(a) assuming that Lutter qualifies as prior art under 35 U.S.C. § 102(e) (which, in any event, Lutter does not). For at least this reason, the Applicant respectfully requests reconsideration and withdrawal of the rejection to claims under 35 U.S.C. § 103(a) in view of Lutter, Salb, and Mauel.

CONCLUSION

In summary, claims 1-7 and 9-19, meet the substantive requirements for patentability. The case is in appropriate condition for allowance. Accordingly, such action is respectfully requested.

If a telephone or vide conference would expedite allowance or resolve any further questions, such a conference is invited at the convenience of the Examiner.

Respectfully submitted,

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Date: July 7, 2004

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